

**Amendment to the Drawings:**

The attached sheet of drawings includes changes to FIG. 1. This sheet, which includes FIGS. 1-4, replaces the original sheet including FIGS. 1-4.

Attachment: Replacement Sheet

**REMARKS**

The present application has been reviewed in light of the Office Action mailed April 20, 2006. By this amendment, claims 9 and 29 have been amended to correct their respective dependencies; FIG. 1 has been amended to show and identify an embodiment of a tube; and the specification has been amended to conform to amended FIG. 1. Applicant submits that these amendments add no new matter. Claims remain 1-32 remain pending in the application. Early and favorable reconsideration of this application is respectfully requested in view of the amendments and the following remarks.

Claim 29 has been objected to as being an apparatus claim dependent on a method claim. Claim 29 has been amended herein to correct its dependency to depend from claim 28. Accordingly, Applicant submits that the objection to claim 29 has been overcome.

The drawings have been objected to under 37 C.F.R. 1.83(a) as failing to show every feature of the invention specified in the claims. The Office Action stated that "the tube (Claim 2) must be shown or the feature(s) canceled from the claims." (Office Action at page 2.) FIG. 1 has been amended herein to show and identify an embodiment of a tube. Applicant submits that the amendments to FIG. 1 add no new matter and that the "Replacement Sheet" of drawings, including new FIG. 1, is in compliance with 37 C.F.R. 1.83(a). Accordingly, Applicant submits that the objection to the drawings should be withdrawn.

Claims 1-5, 7-9, 12-16, and 18-32 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,215,521 (Cochran et al). Applicant respectfully submits that independent claims 1, 19, 28 and 31 are each allowable over Cochran et al. '521. Accordingly, this rejection is respectfully traversed.

In order to properly establish that Cochran et al. '521 anticipates the claims under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

In this case, however, Cochran et al. '521 does not teach each and every element of the claims. For example, each of independent claims 1, 19, 28 and 31 recites, *inter alia*, a bag having folds including at least one transverse fold (as recited in claim 1), folding the bag transversely with respect to the longitudinal axis (as recited in claim 19), the bag being folded over onto itself so as to form a transverse fold (as recited in claim 28), or wherein the bag is folded over onto itself such that the bag axis is oriented substantially parallel to the longitudinal axis of the shaft (as recited in claim 31). Cochran et al. '521 fails to disclose at least these features of the claims.

Cochran et al. '521 discloses an apparatus and procedures for removal of an organ from a body cavity in a morsellated condition through the utilization of an entrapment envelope sheath 22. Cochran et al. '521, however, is silent about any folds in the envelope, let alone transverse folds, folding the bag transversely, or being folded over onto itself such that the axis is oriented substantially parallel to the longitudinal axis of the shaft. Apparently recognizing that Cochran et al. '521 is silent on such features, however, the Examiner asserts that Cochran et al. '521 disclose a "bag (22) *inherently capable of* having folds including at least one transverse fold"; "the bag is *inherently capable of* being folded over onto itself so as to form a transverse fold"; and "the bag is *capable of* being folded over onto itself such that the bag axis is oriented substantially parallel to the longitudinal axis of the shaft." (Office Action at pages 4, 7, 8, emphasis added).

Notably, the Examiner asserts only that the device of Cochran et al. '521 is *capable of* having folds or being folded. In contrast the claims recite *inter alia*, a bag having folds including at least one transverse fold (as recited in claim 1), folding the bag transversely with respect to the longitudinal axis (as recited in claim 19), the bag being folded over onto itself so as to form a transverse fold (as recited in claim 28), or wherein the bag is folded over onto itself such that the bag axis is oriented substantially parallel to the longitudinal axis of the shaft (as recited in claim 31). For at least this reason, the Examiner has failed to establish that Cochran et al. '521 teaches each and every element of the claims.

Additionally, to the extent that the Examiner is asserting that the device of Cochran et al. inherently discloses the claimed features related to a fold or folding, the Examiner has not carried the burden. Indeed, “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” M.P.E.P. § 2112 IV, *quoting In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Section 2112 of the M.P.E.P. further instructs

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

Here, the Examiner has provided no evidence that the claimed features relating to a fold or folding are *necessarily* present in Cochran et al. As a result, the Examiner has failed to establish that Cochran et al. inherently teaches the features of independent claims 1, 19, 28 and 31 relating to a fold or folding. Accordingly, Applicant respectfully requests that the rejections of the independent claims 1, 19, 28 and 31 as being anticipated by Cochran et al. ‘521, under 35 U.S.C. 102(b), be withdrawn.

Since claims 2-18 depend, directly or indirectly, from independent claim 1 and contain all of the features of independent claim 1, for the reasons presented above, regarding the patentability of independent claim 1, Applicant respectfully submits that claims 2-18 are also

patentable over Cochran et al. '521.

Since claims 20-27 depend, directly or indirectly, from independent claim 19 and contain all of the features of independent claim 19, for the reasons presented above, regarding the patentability of independent claim 19, Applicant respectfully submits that claims 20-27 are also patentable over Cochran et al. '521.

Since claims 29 and 30 depend, directly or indirectly, from independent claim 28 and contain all of the features of independent claim 28, for the reasons presented above, regarding the patentability of independent claim 28, Applicant respectfully submits that claims 29 and 30 are also patentable over Cochran et al. '521.

Since claim 32 depends, directly from independent claim 31 and contains all of the features of independent claim 31, for the reasons presented above, regarding the patentability of independent claim 31, Applicant respectfully submits that claim 32 is also patentable over Cochran et al. '521.

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cochran et al. '521 in view of U.S. Patent 5,899,694 (Summer). The rejection of claim 6 under 35 U.S.C. § 103(a) is respectfully traversed. Summer '694 provides for a gingival retraction apparatus including a loop of cord 16, projecting out from one end of an elongate sleeve 18 to be placed around the base of a tooth. The Examiner relies on Summer '694 for the teaching of a sheath fabricated from a flexible heat-shrinking polymer. Applicant submits that Summer '694 fails to

remedy the deficiencies of Cochran et al. '521 and thus can not be properly combined therewith to render claim 6 obvious. Moreover, since claim 6 depends indirectly from independent claim 1 and contains all of the features of independent claim 1, for the reasons presented above, regarding the patentability of independent claim 1, Applicant respectfully submits that claim 6 is also patentable over Cochran et al. '521.

Claims 10 and 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Cochran et al. '521 in view of U.S. Patent 6,402,722 (Snow et al). The rejection of claims 10 and 11 under 35 U.S.C. 103(a) is respectfully traversed. Applicant submits that Snow '722 fails to remedy the deficiencies of Cochran et al. '521 and thus can not be properly combined therewith to render claims 10 and 11 obvious.

Snow '722 is directed to an apparatus and method for percutaneously placing gastrostomy tubes, wherein the apparatus includes a rip-cord capable of tearing a sheath. The Examiner relies on Snow '722 for the teachings of a device including a cord operatively connected to the tear line for facilitating the tearing of the sheath along the tear line. Moreover, since claims 10 and 11 depend indirectly from independent claim 1 and contain all of the features of independent claim 1, for the reasons presented above, regarding the patentability of independent claim 1, Applicant respectfully submits that claims 10 and 11 are also patentable over Cochran et al. '521.

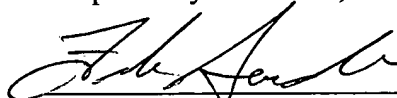
Claim 17 was rejected under 35 U.S.C. 103(a) as being unpatentable over Cochran et al. '521. The rejection of claim 17 under 35 U.S.C. 103(a) is respectfully traversed. In view of the

reasons state above, Applicants respectfully submits that claim 17 is patentable over Cochran et al. '521. Moreover, since claims 17 depends directly from independent claim 1 and contain all of the features of independent claim 1, for the reasons presented above, regarding the patentability of independent claim 1, Applicant respectfully submits that claim 17 is also patentable over Cochran et al. '521.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, the Examiner is respectfully requested to telephone Applicant's undersigned representative at the number indicated below.

In view of the foregoing amendments and remarks, reconsideration of the application and allowance of claims 1-32 is earnestly solicited.

Respectfully submitted,



\_\_\_\_\_  
Francesco Sardone  
Reg. No. 47,918  
Attorney for Applicants(s)

**CARTER, DeLUCA, FARRELL & SCHMIDT, LLP**  
445 Broad Hollow Road, Suite 225  
Melville, New York 11747  
Phone: (631) 501-5700  
Fax: (631) 501-3526  
FS/nr